

REMARKS/ARGUMENTS

A. Interview

Pursuant to Rule 37 CFR 1.133(b), the Applicants acknowledge with gratitude the telephone interview with Examiner Gross and his Supervisor Examiner Paras on August 17, 2006. The priority dates of the applications with regard to the provisional double-patenting rejections were discussed as well as proposed claim amendments with regard to the claim rejection under 35 U.S.C. §112 second paragraph. Although the Examiners were favorably disposed to the proposed claim amendments, and withdrawal of the provisional double-patenting rejection, no agreement was reached.

B. Status of the Claims

Claims 80 and 84-88 are pending. Claim 80 has been amended to clarify the meaning of "consisting essentially of" in the claim as discussed with the Examiner during a teleconference on August 17, 2006. No new matter is added with this amendment.

C. Rejection under 35 USC 112 second Paragraph

The Examiner has maintained the rejection of claims 80 and 84-88 as allegedly being indefinite for recitation of the phrase "consisting essentially of." As amended, claim 80 now more expressly states that the composition has two domains which are more fully defined so that the position of the interactor domains cannot be altered. Specifically, the amended claim makes clear that a first interactor domain is fused to the N-terminal breakpoint of the circularly permuted β -lactamase protein, and a second interactor domain is fused to the C-terminal breakpoint of the circularly permuted β -lactamase protein.

D. Provisional Double-Patenting Rejection

The Examiner has maintained the provisional double-patenting rejection for claims 80, 84-88 as being unpatentable over claims 63-74 of copending Application No. 10/668,778. MPEP §804(I)(B)(1) states:

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only

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rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

As discussed with the Examiner during the telephone conference of August 17, 2006, the present application filed on January 16, 2001, has an earlier filing date over the copending Application No. 10/668,778 filed on September 23, 2003. In light of the earlier filing date of the present application and as discussed with the Examiner during the teleconference, the Applicants respectfully request that the provisional double-patenting rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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